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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,974

01/11/2005

Takehiko Nakano

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03/19/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

YOUSEFI, SHAHROUZ

ART UNIT

PAPER NUMBER

2132

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/520,974	<b>Applicant(s)</b> NAKANO ET AL.	
	<b>Examiner</b> SHAHROUZ YOUSEFI	<b>Art Unit</b> 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/11/2005 &amp; 05/12/2006 &amp; 12/20/2007</u> .            | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph, due to lack of written description. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. See MPEP 2164.08 (a).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 7, 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Shirakawa (JP 2002-175224).

All references are to the translation provided by Applicant on 12/20/2007.

With respect to claim 1, Shirakawa teaches that path disconnection means for connecting/disconnecting (switch part 21, see fig. 1) a path between said external network and said home network (a line switch part 21, fig. 1 is provided between a LAN1 as the internal network in limited meaning, and a WAN3 as the external network, abstract); and local environment management means for making said path disconnection means operate to isolate said home network from said external network based on a request generated by said device on said home network (control part 21 that makes a request for connecting and disconnecting is part of the device) at timing ensuring communication between devices on said home network (The switch part 21, fig. 1 is switched between a connected condition and disconnected condition by control of a part 22, fig1. and an access from the WAN3 to the computer 11 in the LAN1, abstract).

Claim 7 differs from claim 1 only in that claim 1 is a system claim whereas, claim 7 is a method claim. Thus, claim 7 is analyzed as previously discussed with respect to claim 1 above.

With respect to claim 13, Shirakawa teaches local environment management means for requesting disconnection to isolate said home network from said external network at timing ensuring communication between said devices on said home network (when a control means makes a switching means a substantial cutting condition access to an internal network from an external network serves as impossible, par. [0010]).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakawa (JP 2002-175224) in view of Hoshino (JP 2002-007233).

With respect to claim 2, Shirakawa teaches doesn't teach the home server. However, Hoshino teaches that one of said devices is a home server for legitimately acquiring contents from said external network via said router, whereas the other of said devices is a client for making a request for said contents to said home server for use; wherein while said home network is being isolated from said external network by said local environment management means, said home server provides said contents and/or issues a license for said contents to said client (a control terminal 3 receives the demand from an external network, and has the function transmitted to an internal network. Moreover, the data of an internal network are received and it has the function

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transmitted to an external network. In this drawing, the seesaw switching box (SSWB) 5 is in the condition of having connected the buffer 34 with the buffer 33, in order to tell the demand signal from the external network 2 to the internal network 1, par. [0020]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Shirakawa with the control terminal and the switch server of Hoshino to isolate internal network by disconnecting it from an external network.

With respect to claim 3, Hoshino teaches that two or more home servers are able to be installed on said home network; wherein said local environment means temporarily disconnects said path between said home network and said external network when providing said contents and/or issuing a license for said contents to said client for each of home server (connection is changed at every inquiry of individual humanity news at the time of the application of wanting to see a certain specific individual's information among the individual humanity news accumulated in the internal network. Information can be kept by passing only necessary minimum information to an external network side, par. [0044]).

With respect to claim 4, Hoshino teaches that said client is able to receive provision of said contents and/or issuance of said license for said contents (in the switch server 31, a central processing unit (CPU) judges proper and the purpose of a demand which were inputted above using a filter program, and if inaccurate, the demand will be canceled, par. [0056]).

With respect to claim 5, Hoshino teaches that said client is able to use contents acquired from a plurality of home servers on said same home network, and, upon connection to a home server on an other home network, said client is not able to use contents acquired from said home servers on said home networks other than said other home network (When a demand is proper, the control signal for changing connection of the switch of the seesaw switching box (SSWB) 35 from SW2 to SW1 is sent to the switch tube system section 32, par. [0057]).

With respect to claim 6, Shirakawa teaches that after completion of local communication on said home network, or after elapse of a predetermined time from a start of local communication, said local environment management means reestablishes said path between said home network and said external network (a change in the connection condition of the circuit switch section 21 and cutting condition by the control section 22 can also be carried out by the time amount which a timer clocks, par. [0030]).

Claims 8-12 differ from claims 1-6 only in that claims 2-6 are a system claim whereas, claims 8-12 are a method claim. Thus, claim 8-12 are analyzed as previously discussed with respect to claims 2-6 above.

With respect to claim 14, Shirakawa teaches that said communication apparatus operates on a home network as a home server for providing contents; wherein said local environment management means requests disconnection to isolate said home network from said external network when providing said contents and/or issuing a license for said contents to said client (said control means shall supervise generating of the predetermined event in said internal network, and shall change whether said



switching means is made into a substantial connection condition according to generating of this predetermined event, or it considers as a substantial cutting condition again, par. [0016]).

With respect to claim 15, said local environment management means requests reestablishment connection between said home network and said external network after completion of local communication with said client (said control means --further-- a time check-- when the time amount clocked by means turns into predetermined time amount, it shall change whether said switching means is made into a substantial connection condition, or it considers as substantial cutting condition, par. [0017]).

With respect to claim 16, Shirakawa teaches that path disconnection means for connecting/disconnecting a path between said external network and said home network (the switch part 21 is switched between a connected condition and a disconnected condition, abstract); and control means for isolating said home network from said external network by making said path disconnection means operate by making said path disconnection means operate based on a request generated by said device on said home network (control part 21 that makes a request for connecting and disconnecting is part of the device) at timing ensuring communication between devices on said home network (control of a control part 22, and an access from the WAN3 to the computer 11 in the LAN1 gets impossible in the disconnected condition, abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Shirakawa with the control terminal and the switch

server of Hoshino to isolate internal network by disconnecting it from an external network.

With respect to claim 17, Shirakawa teaches that said control means isolates said home network from said external network in response to a disconnection request from said home server providing contents on said home network (control of a control part 22, and an access from the WAN3 to the computer 11 in the LAN1 gets impossible in the disconnected condition, abstract).

With respect to claim 18, Shirakawa teaches that said control means reestablishes said connection between said home network being disconnected and said external network in response to a reestablishment request from said home server providing contents on said home network (it is characterized by having the control means which changes whether said switching means is made into a substantial connection condition, or it considers as a substantial cutting condition, par. [0014]).

With respect to claim 19, Shirakawa teaches that said control means reestablishes said connection between said home network and said external network at predetermined timing after isolating said home network from said external network in response to a disconnecting request from said home server providing contents on said home network (a change in the connection condition of the circuit switch section 21 and cutting condition by the control section 22 can also be carried out by the time amount which a timer clocks, par. [0030]).

With respect to claim 20, Shirakawa teaches that means for communicating with said external network during said home network and said external network are being

disconnected; and means for confirming disconnection of said path between said home network and said external network by accessing to a predetermined server on said external network during a period when said home network and said external network are being disconnected (said control means shall supervise generating of the predetermined event in said internal network, and shall change whether said switching means is made into a substantial connection condition according to generating of this predetermined event, or it considers as a substantial cutting condition again, par. [0016]).

With respect to claim 21, Shirakawa teaches that a step of acquiring timing for ensuring communication between devices on said home network; and a step of temporarily disconnecting a path between said external network and said home network so as to isolate said home network from said external network based on a request generated by said device on said home network (control part 21 that makes a request for connecting and disconnecting is part of the device) at said acquiring timing (said control means turns into predetermined time amount, it shall change whether said switching means is made into a substantial connection condition, or it considers as a substantial cutting condition, par. [0017]). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Shirakawa with the control terminal and the switch server of Hoshino to isolate internal network by disconnecting it from an external network.

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### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHROUZ YOUSEFI whose telephone number is (571) 270-3558. The examiner can normally be reached on Monday-Thursday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Y./

Shahrouz Yousefi

Examiner

03/10/2008

/Gilberto Barron Jr/

Supervisory Patent Examiner, Art Unit 2132